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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,391	10/07/2004	Jonathon Leigh Napper	NPW012US	6473

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

CHOJNACKI, MELLISSA M

ART UNIT	PAPER NUMBER
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2164

MAIL DATE	DELIVERY MODE
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06/28/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/510,391

Applicant(s)

NAPPER ET AL.

Examiner

Mellissa M. Chojnacki

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.


SAM RIMELL
PRIMARY EXAMINER

DETAILED ACTION

Specification

The specification is object too because:

1. The abstract contains the phrase "is disclosed". The abstract should not contain "disclosed". Correction is required.
2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is not limited to a method that runs on a medium and does not produce or display a concrete result. As such, the claim is not limited to statutory subject matter

and is therefore non-statutory. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Claims 2-16 are rejected under 35 U.S.C. 101 because they are dependent upon rejected independent claim 1.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-23, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 17, recite the limitation "specialized format", which renders the claim vague and indefinite, because it is unclear as to what "specialized format" signifies in the claims.

Claims 2-16 and 18-23 are rejected under 35 U.S.C. 101 because they are dependent upon rejected independent claims 1 and 17.

Claim 1, also recites the limitation "determining" and "selecting", which renders the claim vague and indefinite, because it is unclear if the "input query" contains the "specialized format" that is being determined, also it is unclear where or how the determining is being done. Furthermore, it is also unclear who or from where the selecting is being done. Clarifications are required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Lopresti et al. (U.S. Patent No. 5,832,474).

As to claim 1, Lopresti et al. teaches a method of improving accuracy in searching digital ink (See abstract; column 3, lines 16-28), the method comprising: receiving a search input query (See column 3, lines 16-33); determining a specialized format of digital ink (See column 3, lines 16-28, where "patterns" is read on "format");

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selecting a digital ink searching algorithm based on the determined specialized format of digital ink (See column 2, lines 60-67; column 3, lines 1-2, lines 16-28; column 13, lines 11-18); and, searching the digital ink for a match to the search input query by utilising the selected digital ink searching algorithm (See column 2, lines 60-67; column 3, lines 1-2, lines 16-28; column 13, lines 11-18).

As to claim 2, Poon et al. teaches wherein the specialized format of digital ink is determined automatically, based on the digital ink to be searched (See column 3, lines 16-28).

As to claim 3, Lopresti et al. teaches wherein the specialized format of digital ink is determined automatically, based on the search input query (See column 3, lines 16-28).

As to claim 4, Lopresti et al. teaches wherein the specialized format of digital ink is determined automatically, based on information contained in a document associated with the digital ink to be searched (See column 3, lines 16-28).

As to claim 5, Lopresti et al. teaches wherein the specialized format of digital ink is determined manually, by a user selecting the specialized format of digital ink (See column 3, lines 16-28).

As to claim 6, Lopresti et al. teaches wherein the specialized format of digital ink is determined manually, by a parameter associated with the system processing the digital ink (See column 3, lines 16-28, where "spatial and temporal components" is read on "parameter").

As to claim 7, Lopresti et al. teaches wherein the specialized format of digital ink is determined automatically, based on a font contained in the document associated with the digital ink to be searched (See column 3, lines 16-28; column 8, lines 13-61).

As to claim 8, Lopresti et al. teaches wherein the specialized format of digital ink is determined based on a document label or document setting associated with the digital ink (See column 8, lines 13-61; column 11, lines 61-67).

As to claim 9, Lopresti et al. teaches wherein the specialized format of digital ink is determined based on a document field label associated with the digital ink (See column 8, lines 13-61; column 11, lines 61-67).

As to claim 10, Lopresti et al. teaches wherein the specialized format of digital ink is determined based on a document field attribute associated with the digital ink (See column 8, lines 13-61; column 11, lines 61-67).

As to claim 11, Lopresti et al. teaches wherein the specialized format of digital ink is determined based on an analysis of the characteristics of the digital ink to be searched (See column 8, lines 13-61; column 11, lines 61-67).

As to claim 12, Lopresti et al. teaches wherein the specialized format of digital ink is determined based on a written language or script of the digital ink to be searched (See column 8, lines 13-61; column 11, lines 61-67).

As to claim 13, Lopresti et al. teaches wherein the specialized format of digital ink is determined based on a written character set of the digital ink to be searched (See column 8, lines 13-61; column 11, lines 61-67).

As to claim 14, Lopresti et al. teaches wherein the specialized format of digital ink is determined based on differentiating written text from drawings in the digital ink to be searched (See column 8, lines 13-61; column 11, lines 61-67).

As to claim 15, Lopresti et al. teaches wherein the search input query is of a type from the group of: textual; numerical; alphanumerical; pictorial; or graphical (See column 3, lines 16-28; column 8, lines 13-61; column 11, lines 61-67).

As to claim 16, Lopresti et al. teaches wherein an indicating label of the specialized format of digital ink is stored with the digital ink (See column 3, lines 16-28;

column 8, lines 13-61; column 11, lines 61-67).

As to claim 17, Lopresti et al. teaches a system for improving accuracy in searching digital ink (See abstract), the system comprising: (1) an input device to receive a search input query (See column 3, lines 16-33); (2) a storage device to store the searchable digital ink (See column 4, lines 4-15); (3) at least one processor in communication with the storage device (See column 4, lines 4-30), the at least one processor adapted to: (A) determine a specialized format of digital ink (See column 3, lines 16-28, where "patterns" is read on "format"); (B) select a digital ink searching algorithm based on the determined specialized format of digital ink (See column 2, lines 60-67; column 3, lines 1-2, lines 16-28; column 13, lines 11-18); and, (C) search the digital ink for matches to the search input query by utilising the selected digital ink searching algorithm (See column 2, lines 60-67; column 3, lines 1-2, lines 16-28; column 13, lines 11-18); and, (4) an output device to display one or more search results (See column 7, lines 1-6).

As to claim 18, Lopresti et al. teaches wherein the input device is a pen-based input device (See abstract; column 1, lines 12-16).

As to claim 19, Lopresti et al. teaches wherein the input device is a keyboard or keypad (See column 1, lines 44-45).

As to claim 20, Lopresti et al. teaches wherein the output device is a printer or a visual display (See column 7, lines 1-6).

As to claim 21, Lopresti et al. teaches wherein the digital ink is associated with one or more of a document label, a document setting, a document field label or a document field attribute, and the specialized format of digital ink is determined from one or more of the document label, the document setting, the document field label or the document field attribute (See column 3, lines 16-28; column 8, lines 13-61; column 11, lines 61-67).

As to claim 22, Lopresti et al. teaches wherein the at least one processor determines the specialized format of digital ink based on user input to the input device (See column 3, lines 16-28; column 8, lines 13-61; column 11, lines 61-67).

As to claim 23, Lopresti et al. teaches the system as claimed in claim 17, the at least one processor adapted to perform the method of any one of the claims 1 to 16 (See column 4, lines 16-30).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to accuracy in searching digital ink in general:

U.S. Patent No. 5,687,254 to Poon et al., for disclosing searching and matching unrecognized handwriting.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mellissa M. Chojnacki whose telephone number is (571) 272-4076. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

June 22, 2007

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A handwritten signature in black ink, appearing to read 'S. Rimell', is positioned above the printed name.

SAM RIMELL
PRIMARY EXAMINER